

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 13

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JHEROEN PIETER DORENBOSCH

Appeal No. 2001-0848
Application 09/144,414

ON BRIEF

Before KRASS, JERRY SMITH and DIXON, Administrative Patent Judges.

JERRY SMITH, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal under 35 U.S.C. § 134 from the examiner's final rejection of claims 1-4, 6-11, 13 and 14, which constituted all the claims in the application. An amendment after final rejection was filed on July 11, 2000 and was entered by the examiner. This amendment cancelled claims 7 and 14. Accordingly, this appeal is directed to the rejection of claims 1-4, 6, 8-11 and 13.

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The disclosed invention pertains to a method and apparatus in a wireless messaging system for estimating and using required delivery parameters to meet a target transmission reliability.

Representative claim 1 is reproduced as follows:

1. A method in a wireless messaging system for estimating and using required delivery parameters to meet a target transmission reliability, the method comprising the steps of:

monitoring delivery of outbound messages to a plurality of two-way portable messaging units, said outbound messages being of a type for which an acknowledgement is expected;

recording reliability statistics for said outbound messages as a function of delivery parameters;

determining the target transmission reliability for sending a message of a type for which an acknowledgment is not expected;

estimating, from said reliability statistics, the required delivery parameters for sending said message at said target transmission reliability; and

transmitting said message in accordance with the required delivery parameters.

The examiner relies on the following references:

Blasbalg	4,771,391	Sep. 13, 1988
Mahany	5,862,171	Jan. 19, 1999
		(filed June 06, 1995)

The standard TCP/IP protocols.

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Claims 1-4, 6, 8-11 and 13 stand rejected under 35 U.S.C. § 103. As evidence of obviousness the examiner offers Mahany and the standard TCP/IP protocols with respect to claims 1, 3, 4, 6, 8, 10, 11 and 13, and the examiner adds Blasbalg to this combination with respect to claims 2 and 9.

Rather than repeat the arguments of appellant or the examiner, we make reference to the brief and the answer for the respective details thereof.

OPINION

We have carefully considered the subject matter on appeal, the rejections advanced by the examiner and the evidence of obviousness relied upon by the examiner as support for the rejections. We have, likewise, reviewed and taken into consideration, in reaching our decision, the appellant's arguments set forth in the brief along with the examiner's rationale in support of the rejections and arguments in rebuttal set forth in the examiner's answer.

It is our view, after consideration of the record before us, that the evidence relied upon and the level of skill in the particular art would not have suggested to one of ordinary skill in the art the obviousness of the invention as set forth in the claims on appeal. Accordingly, we reverse.

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In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the examiner to establish a factual basis to support the legal conclusion of obviousness. See In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986); ACS Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the examiner are an essential part of complying with the burden of presenting a prima facie case of obviousness. Note In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). If that burden is met, the burden then shifts

to the applicant to overcome the prima facie case with argument and/or evidence. Obviousness is then determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. See Id.; In re Hedges, 783 F.2d 1038, 1039, 228 USPQ 685, 686 (Fed. Cir. 1986); In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984); and In re Rinehart, 531 F.2d 1048, 1052, 189 USPQ 143, 147 (CCPA 1976). Only those arguments actually made by appellant have been considered in this decision. Arguments which appellant could have made but chose not to make in the brief have not been considered and are deemed to be waived by appellant [see 37 CFR § 1.192(a)].

We consider first the rejection of claims 1, 3, 4, 6, 8, 10, 11 and 13 based on the teachings of Mahany (and the TCP/IP Standards). With respect to independent claims 1 and 8, the examiner indicates how he has determined these claims to be obvious over the applied prior art [answer, pages 6-8]. The examiner's finding of obviousness is based inter alia on a determination that Mahany inherently provides the step of determining a target transmission reliability for sending messages as well as a taking of Official Notice that transmitting messages for which an acknowledgment is expected in a segmented

data communication system was well known in the art as set forth in the standard TCP/IP protocols.

Although appellant has nominally indicated that independent claims 1 and 8 stand or fall separately [brief, page 9], the arguments section of the brief argues these two claims as a single group. Therefore, we will consider claims 1 and 8 as constituting a single group for purposes of this appeal. Appellant argues that Mahany does not teach or suggest monitoring delivery of messages of a type for which an acknowledgment is expected to obtain reliability information for sending messages of a type for which an acknowledgment is not expected. Appellant notes that Mahany only deals with messages for which an acknowledgment is expected. Appellant argues that the examiner's taking of Official Notice is based on a finding which is opposite to what Mahany states. Appellant also argues that knowledge of the TCP/IP protocol would not have led the artisan to use reliability statistics obtained from messages sent when an acknowledgment is expected to estimate or calculate delivery parameters needed for messages sent when an acknowledgment is not expected. Finally, appellant argues that the examiner's unsubstantiated conclusion that one protocol encapsulates the other protocol is not correct [brief, pages 11-14].

The examiner responds that the standard TCP/IP protocol teaches that an adjustment in the size of the TCP packet must naturally result in adjustment in the size of the IP packet, citing Ranagathan (U. S. Patent No. 5,931,961). The examiner responds that providing TCP/IP in Mahany's system would inherently result in adjusting the packet sizes of IP packets (messages without acknowledgment) by monitoring the reliability statistics of the TCP packets (messages with acknowledgment). The examiner also asserts that appellant has failed to timely challenge the examiner's taking of Official Notice [answer, pages 10-13].

We will not sustain the examiner's rejection of independent claims 1 and 8 because the examiner has failed to establish a prima facie case of obviousness. Initially, we note that we will not consider the teachings of Ranagathan because it was not used in the statement of the rejection. We also note that the examiner's rejection improperly relies on the examiner's findings of what is deemed to be inherent in the prior art teachings and on the examiner's taking of Official Notice as to certain facts. First, inherency will not support a rejection under 35 U.S.C. § 103 when these findings are challenged by appellant. Second, appellant is not precluded from arguing the

taking of Official Notice in the appeal brief as asserted by the examiner. Since appellant has argued the taking of Official Notice while the case was still before the examiner, we find that this argument is timely made.

Just as important, however, is the fact that even if all the examiner's findings were accepted, there is still no prima facie case of obviousness. The standard TCP/IP protocol only establishes that it was known to send messages in which a response was expected as well as messages in which no response was expected. Even if one accepts that this finding is correct, there is still no suggestion within the applied prior art that statistics obtained from messages sent when a response is expected would be used to estimate the required delivery parameters for sending messages in which no response is expected at a target transmission reliability. The examiner has provided no motivation, and we have found none, as to why the artisan would have been motivated to modify the system of Mahany as proposed by the examiner except to recreate the claimed invention in hindsight.

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Since we have not sustained the rejection of independent claims 1 and 8, we also do not sustain the rejection of claims 3, 4, 6, 10, 11 and 13 which depend therefrom. With respect to the rejection of claims 2 and 9 based on Mahany and Blasbalg, since Blasbalg does not overcome the deficiencies of Mahany discussed above, we also do not sustain the rejection of claims 2 and 9.

In conclusion, we have not sustained either of the examiner's rejections of the claims on appeal. Therefore, the decision of the examiner rejecting claims 1-4, 6, 8-11 and 13 is reversed.

REVERSED

ERROL A. KRASS)	
Administrative Patent Judge)	
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JERRY SMITH)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES
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)	
JOSEPH L. DIXON)	
Administrative Patent Judge)	

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Motorola, Inc.
600 North US Highway 45
Libertyville, IL 60048-5343

JS/ki